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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,040	03/30/2001	Kelly Ervin Sonderegger	56932.000005	5143
909	7590	12/13/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			POND, ROBERT M	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

3625

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/821,040	Applicant(s) SONDEREGGER ET AL.	
	Examiner Robert M. Pond	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant newly added claims 20-23. All pending claims (1-23) were examined in this final office action necessitated by amendment.

### ***Requirement for Information***

1. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: marketing brochures, user's manuals, developer's manuals, white papers pertaining to Assignee's DigitalMe identity service. The following press releases issued by the Assignee and supporting articles were recently discovered by the examiner while updating the prior art search:
  - "Novell's Digitalme and NDS eDirectory for consumers to streamline their online purchases," 29 March 2000," PR Newswire. This press release discloses the Assignee's Digitalme identity services:
    - i. that protects consumer identity on the Internet.
    - ii. stores personal information such as passwords, user names, account numbers, contact information, and preferences securely and privately.

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- iii. Allows consumers to have complete access and control over their personal information which can be amended, shared or deleted for different audiences.
- iv. Supports Internet, intranet, and extranet, wired to wireless, corporate and public as one net.
- v. Launch date of October 1999.
- "Novell tries to make e-commerce, privacy compatible—system allows users to set limits on information disclosed," Satran, Dick; Seattle Times, 14 April 1999, pgD.5. This article discloses the Assignee's Digitalme service:
  - i. users providing their credit cards or other personal information they wish to share and list preferences.
  - ii. Provides the user with a digital identity, offering privacy protection, while letting users disclose enough about themselves to do business.
- "Passwords—who needs 'em? Digital wallets help shoppers," Spector et al., PC World, March 2000, v18i3pg70; Proquest #49848563, 3pgs; discloses Assignee's Digitalme service:
  - i. that uses a card metaphor to protect privacy that lets the user reveal varying amounts of information to different people.
  - ii. Automatically can fill out forms using data on the Digitalme card the consumer chooses.
  - iii. stores private data on its servers in encrypted form.

- “Novell provides privacy, directory services at same time,” The Daily Yomiuri, 27 April, 1999. Discloses the Assignee demonstrating Digitalme services:
  - i. addresses the issue of consumers having to enter personal information and becoming concerned with how this information will be used.
  - ii. addresses the issue of entering and re-entering the same personal information.
  - iii. identifies meCards that control what information is shared with a particular web site, along with how and by whom the user’s identity may be used.
- “Microsoft and Novell compete in creating single Internet sign-of for your e-shopping,” McClure et al., InfoWorld, 15 November 1999, v21i46pg66. Discloses Novell’s Digitalme services competing against Microsoft’s Passport service and both companies positioning themselves as infomediaries.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 2. Claims 1-15 are rejected under 35 USC 102(e) as being anticipated by Brody et al. (Paper #5, patent application publication 2001/0029485, hereinafter referred to a “Brody”).**

Brody teaches all the limitations of Claims 1-15. For example, Brody discloses a method for enabling a user to transact an anonymous online purchase and payment (please see at least abstract; paragraph 0002 through paragraph 0010). Brody discloses a system for enabling a user to transact an anonymous online transaction featuring remote computers connected to an anonymous transaction server via the Internet communicating with online merchants (please see at least abstract; page 1, 0002 through page 2, 0010). Brody discloses an anonymous transaction server that generates customer profiles containing true customer profile data and anonymous customer profile data. Brody further discloses:

- Providing an anonymous user interface: pseudo-random name attribute (please note: manipulates customer name) may provide benefit that true name is not known to the merchant (see at least abstract; 0009, 0037);

consumer uses a graphical user interface, makes anonymous payment, and never exposes true identity to merchant (see at least 0048). Please note examiner's interpretation: consumer using a graphical user interface using anonymous data whereby the merchant does not know the true identity of the consumer is using an anonymous graphic user interface.

- Accessing a first profile comprising user data: first profile contains true user data (see at least page 2, 0011, 0012; page 6, 0041).
- Generating a second profile linked to the first profile: second profile contains anonymous data linked to first profile (see at least page 2, 0016).
- Single use transaction number associated with user credit card: (see at least page 5, 0039).
- Alias name: Pseudo-random attributes (e.g. customer name) (see at least page 1, 0009).
- Storing profile information: browser cookies, using cookies to store information on a user's computer, using cookies containing any arbitrary information, cookies containing information to authenticate or identify a registered user of a web site without requiring them to sign in again every time they access the site, user cookies used to facilitate communication between the merchant and the anonymous transaction server storing customer information in a cookie comprising name, address, account information (please note: address information provides demographic profiling information); using cookies for site personalization (please note

examiner's interpretation: user profile determines what information to present to the user) (see at least 0047).

- Communicating the anonymous data from second profile without user interaction: ATS uses customer's cookie to automatically obtain the merchant's URL; through cookie ATS and merchant site can communicate without consumer interaction (see at least 0047).
- Anonymous address: customer supplies anonymous card data (please note: anonymous card data includes customer's address as disclosed on page 6, 0041) upon merchant request for card number, shipping address, and name (see at least Fig. 3 (65); page 1, 0005; page 6, 0041; page 7, 0045).
- Accessing over secure communication path: (see at least page 6, 0041).
- Concurrently displaying: merchant's web page and interactive pop-up applet or payment panel to facilitate the generation or use of an anonymous card (please note examiner's interpretation: pop-up applet or payment panel provides options to the customer (see at least page 7, 0048-0049).

Pertaining to system claims 6-15

Rejection of claims 6-15 is based on the same rationale as noted above.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 17-23 are rejected under 35 USC 103(a) as being unpatentable over Brody (Paper #5, patent application publication 2001/0029485), in view of Official Notice (regarding old and well-known)**

Brody teaches a method for enabling a user to transact an anonymous online purchase and payment (please see at least abstract; paragraph 0002 through paragraph 0010). Brody teaches a system for enabling a user to transact an anonymous online transaction featuring remote computers connected to an anonymous transaction server via the Internet communicating with online merchants (please see at least abstract; page 1, 0002 through page 2, 0010). Brody teaches an anonymous transaction server that generates customer profiles containing true customer profile data and anonymous customer profile data. Brody further teaches:

- *Providing an anonymous user interface:* pseudo-random name attribute (please note: manipulates customer name) may provide benefit that true name is not known to the merchant (see at least abstract; 0009, 0037); consumer uses a graphical user interface, makes anonymous payment,

and never exposes true identity to merchant (see at least 0048). Please note examiner's interpretation: consumer using a graphical user interface using anonymous data whereby the merchant does not know the true identity of the consumer is using an anonymous graphic user interface.

- Accessing a first profile comprising user data: first profile contains true user data (see at least page 2, 0011, 0012; page 6, 0041).
- Generating a second profile linked to the first profile: second profile contains anonymous data linked to first profile (see at least page 2, 0016).
- Single use transaction number associated with user credit card: (see at least page 5, 0039).
- Alias name: Pseudo-random attributes (e.g. customer name) (see at least page 1, 0009).
- Storing profile information: browser cookies, using cookies to store information on a user's computer, using cookies containing any arbitrary information, cookies containing information to authenticate or identify a registered user of a web site without requiring them to sign in again every time they access the site, user cookies used to facilitate communication between the merchant and the anonymous transaction server storing customer information in a cookie comprising name, address, account information (please note: address information provides demographic profiling information); using cookies for site personalization (please note

examiner's interpretation: user profile determines what information to present to the user) (see at least 0047).

- Communicating the anonymous data from second profile without user interaction: ATS uses customer's cookie to automatically obtain the merchant's URL; through cookie ATS and merchant site can communicate without consumer interaction (see at least 0047).
- Anonymous address: customer supplies anonymous card data (please note: anonymous card data includes customer's address as disclosed on page 6, 0041) upon merchant request for card number, shipping address, and name (see at least Fig. 3 (65); page 1, 0005; page 6, 0041; page 7, 0045).
- Accessing over secure communication path: (see at least page 6, 0041).
- Concurrently displaying: merchant's web page and interactive pop-up applet or payment panel to facilitate the generation or use of an anonymous card (please note examiner's interpretation: pop-up applet or payment panel provides options to the customer (see at least page 7, 0048-0049).

Brody teaches all the above as noted under the 103(a) rejection and teaches pop-up panels serving as a transaction interface concurrently displayed with the graphical user interface, but does not disclose displaying the anonymous transaction interface whenever the browser is displayed. The Examiner takes the position that it is old and well-known in the arts to display panels such as toolbars

concurrently and persistently in web browsers or other types of graphical user interfaces to provide application selection convenience for the user. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Brody to implement toolbars for application selection as taught by Official Notice, in order to provide a user convenience.

### ***Response to Arguments***

Applicant's arguments filed 27 September 2005 have been fully considered but they are not persuasive. Brody discloses the use of cookies used to connect the anonymous transaction system with the merchant via the customer computer without requiring user interaction. Brody discloses the use of web pages for anonymous user as previously cited and further discloses the use of pop-up interactive applets or payment panel that provide concurrent displaying of the merchants web page and the automatic transaction server applet. Pop-up applet or payment panel provides options (see at least page 7, 0048-0049).

Regarding Official Notice, tool bars and/or pop-ups being displayed in conjunction with a user interface have been available from the early days of Microsoft Windows dating back to the mid-90's.

The Examiner is suggesting the Applicant consider a telephonic interview for further discussion.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Novell: "Novell's Digitalme and NDS eDirectory for Consumers to Streamline their online purchases," PR Newswire, 29 March 2000, Proquest #52024806, 3pgs; discloses Novell's identity services that protects consumer identity on the Internet.
- Novell: "Novell Tries to make e-commerce, privacy compatible—system allows users to set limits on information disclosed," Satran, Dick; Seattle

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Times, 14 April 1999, pgD.5, Proquest #40548330, 3pgs; This articles discloses the Assignee's Digitalme service:

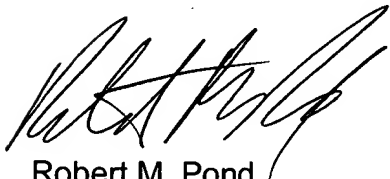
- Novell: "Passwords-who need 'em? Digital wallets help shoppers," Spector et al., PC World, March 2000, v18i3pg70, Proquest #49848563, 3pgs; discloses Novell's Digitalme service that uses a card metaphor to protect privacy.
- Novell: "Novell provides privacy, directory services at same time," The Daily Yomiuri, 27 April, 1999, Proquest #40880863, 3pgs; discloses Novell demonstrating Digitalme services.
- Novell: "Microsoft and Novell compete in creating single Internet sign-of for your e-shopping," McClure et al., InfoWorld, 15 November 1999, v21i46pg66, Proquest #46483507, 2pgs; discloses Novell's Digitalme services competing against Microsoft's Passport service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond  
Primary Examiner  
December 9, 2005